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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 65 – 99 and 182 – 247, 249, 250, and 252 - 334 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 37 of U.S. Patent No. 6,344,853. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present Application are broader versions of claims 1 – 37 of U.S. Pat. No. 6,344,853.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 65 – 99 and 182 – 247, 249, 250, and 252 - 334 are rejected under 35 U.S.C. 102(e) as being disclosed by Bornstein (U.S. Pat. No. 6,144,388) (Process For Displaying Articles of Clothing on an Image of a Person).

4.1 Regarding claim 65, Bornstein discloses a method for generating a composite image including:

presenting a first image via a Web interface presented on a browser (Fig. 4; col. 16, line 55 – col. 17, line 25);

presenting a second image via a Web interface presented on the browser (Fig. 4; col. 16, line 55 – col. 17, line 25);

communicating a selecting of the first image and the second image to a server via a network (Fig. 4; col. 16, line 55 – col. 17, line 25);

automatically generating a composite image of the first image and the second image at the server (Figs. 4 and 6B; col. 16, line 55 – col. 17, line 25); and

communicating the composite image from the server to the browser via the network (Fig. 4; col. 16, line 55 – col. 17, line 25).

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4.2 Per claim 66, Bornstein teaches that the first image is a product image (col. 16, line 61 – col. 17, line 5).

4.3 Regarding claim 67, Bornstein discloses that the second image is a decorative image including any one of a group of images including logo image and a text image (col. 14, line 39 “text objects”).

4.4 Per claim 68, Bornstein teaches that the composite image includes the second image placed in a default position on the first image (Fig. 10A; col. 26, lines 3 - 10).

4.5 Regarding claim 69, Bornstein discloses:

positioning the second image relative to the first image via a Web interface presented on the browser to generate relative positioning information (col. 19, lines 46 - 58);

communicating the relative positioning information to the server via the network (col. 19, lines 46 - 58); and

automatically generating the composite image of the first image and the second image at the server according to the relative positioning information (col. 19, lines 46 - 58).

4.6 Per claim 70, Bornstein teaches that the composite image is associated with information in a database, the associated information in the database being

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communicated together with the composite image from the server to the browser via the network as a photo sample (Figs. 1, 4; col. 1, lines 19 – 20; col. 17, lines 27 – 32 and 55 - 59).

4.7 Regarding claims 71 and 72, Bornstein does not explicitly disclose that the photo sample is sent via network to a specified email address; or teach a URL, containing the photo sample that is sent via network to a specified email address.

It would have been inherent to implement the sending of photo information via email because Bornstein clearly discloses an Internet based system (Fig. 4) for downloading and uploading information through a browser. Email attachments are notoriously well known avenues for delivery of photo information over the Internet.

4.8 Regarding claims 73 – 99, 182 – 247, 249, 250, and 252 - 334, the rejection of claims 65 – 72 under 35 USC 102(e) (paragraphs 4.1 – 4.7 above) applies fully.

In addition Bornstein discloses normalizing dimensions of images (col. 19, lines 46 - 58).

Also, Bornstein teaches two separate memory storage areas (libraries) for storage of the superimposed data (Fig. 4, items 114 and 116; col. 16, lines 55 – 64 “models database”; col. 17, lines 19 – 39 “user’s picture database”).

Response to Arguments

5. Applicant's arguments filed 7/19/05 have been fully considered but they are not persuasive.

Applicant argues that Bornstein does not explicitly disclose "communicating a selecting of the first image and the second image to a server via a network."

Examiner disagrees.

This item is clearly shown in Figure 4 and in the specification of Bornstein (col. 16, line 55 – col. 17, line 25).

Applicant argues that "there is no need to select from a plurality of user images, since each user is capable of supplying its own image ...".

Examiner disagrees.

Figure 4 clearly shows in item 116 a separate database that contains user's information, including a user's 2D picture. This database contains the images of multiple users and "one or more pictures off the user or another person." (col. 17, lines 19 – 26)

Applicant states that there is no disclosure in Bornstein of a "logo image."

Examiner disagrees.

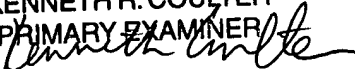
Bornstein discloses that the second image is a decorative image including any one of a group of images including logo image and a text image (col. 14, line 39 "text objects").

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER
PRIMARY EXAMINER


krc